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2569-103P

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IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT: Wells OBRECHT
APPL. NO.: 08/900,360 GROUP: 2765
FILED: July 25, 1997 EXAMINER: CRECCA, M
FOR: METHOD AND APPARATUS FOR PROCURING GOODS IN AN
AUTOMATED MANNER

REPLY UNDER 37 C.F.R. § 1.111

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

June 14, 2000

Sir:

This is a reply to the Office Action mailed February 17, 2000, the response for which having been extended one (1) month to June 19, 2000 as June 17, 2000 was a Saturday.

TELEPHONE INTERVIEW

In a telephone Interview on May 25, 2000, the undersigned questioned the seven references used as a base reference in the Office Action. As understood from the telephone Interview and an Interview Summary faxed to the undersigned that only the UV and X references in addition to the SALMON reference were used in the rejection. Further comments regarding the citation of references in the rejection are set forth below.

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REPLY TO REJECTIONS**First Rejection:**

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Product Source Interactive Software (hereinafter Source Interactive, described in references U, V, W, XU(2), and V(2) in view of Salmon et al. (U.S. Patent No. 5,592,375 "hereinafter Salmon"). This rejection is traversed.

Initially in the rejection, references U, V, W, X, U(2) and V(2) in addition to Salmon were cited. From the body of the rejection, only the references U, V, X and Salmon were used. Therefore, the additional references cited, as they have not been applied, are in fact or law not part of the rejection and no comment is made as no reasons were advanced why these references would apply to the claims. It is requested that the Patent Office withdraw the non-explained references to clarify the record.

The rejection relies on reference "X" titled IBNL FORGES . . . SOFTWARE, January 10, 1996 (hereinafter "X") in paragraph 8 and asserts that the step in claim 1 receiving . . . responses from the at least one seller to the request" is found in that paragraph. Paragraph 8 of reference "X" states as follows:

In an initial step, sellers identify their products and services on a SOURCE enrollment template and can connect with potential customers on demand when a buyer sends out a request that matches any category they have enrolled under. Sellers are connected to the request of all on-line buyers.

The quotation from reference "X", paragraph 8 does not at all meet the steps, in for example claim 1(c) and (d). In the "X" reference, the sellers first identify their products and when a buyer sends out a request that matches the

category, sellers are connected to the request of the buyers. This is completely different than is set forth for example in base claim 1.

Additionally, at least recognizing that the “primary references” cited, do not show or suggest all steps and apparatus as claimed, the Patent Office then relies on Salmon to show for example, the ranking step of claim 1. This step provides a ranking of the sellers. The Patent Office asserts that Salmon teaches such a ranking. This is strongly traversed. What Salmon is doing is ranking the product itself such as real estate, automobiles, aircraft or yachts, etc. See for example, column 2, line 18 and 19. This is quite different than what has been claimed in the method and article.

In the present application, in the context claimed, it is the sellers who are ranked, not the products. Also, there is no “selecting” in the reference. In evaluating the wording of the claims, the Patent Office is again directed to the case of *Multiform Dessiccants Inc. v. Medzam* (cited and discussed in the Reply of May 5, 1999, on pages 4 and 5 of that Reply which was part of an Interview.) Also, in evaluating terms in a claim, reference is also made to the guidelines set forth in MPEP Section 2106 (See *Markman V. Westview Instruments* 38 USPQ, 2nd 1461(1996) which section states as follows:

Office personnel must rely on the Applicants disclosure to properly determine the meaning of terms used in the claims.

While the Patent Office asserts that it would be obvious to combine the teachings of the references, there is no *prima facie* case of obviousness present at least for the two points as follows:

- (1) The structure claimed is not shown or suggested in the combination of the references; or
- (2) Outside of the Applicants own disclosure, there would be no motivation to combine the references.

Point (1) has been discussed above. With respect to the motivation (point 2), it is not understood from the Office Action what Salmon would suggest to one skilled in the art in modifying the primary references, V, X or U. Again, it appears that the Patent Office has only concentrated on the obviousness of the structure or steps, which have really not been shown "instead of the context of the claims regarding the subject matter as a whole." See the "Hybritech" case as cited in the Reply of May 5, 1999, page 5 third full paragraph which is incorporated herein.

With respect to independent claims 10 and 19, the arguments above are also pertinent. The dependent claims rejected are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. §103.

Second Rejection:

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Interactive Source in view of Salmon as applied to claim 19 above.

In this rejection, the Patent Office took Official Notice regarding "previously owned automobiles". Claim 20 is a dependent claim and does not rely on this limitation alone for patentability.

Additionally, the Patent Office referred to Fujisaki (U.S Patent 4,789,928). This patent was not used in the heading of the rejection and thus the use of this reference is improper. See the guidelines set forth in the MPEP § 706.0(j) citing *In re Hoch* 166 USPQ 406 (C CPA 1970) which states as follows:

Where a reference is relied on to support a rejection whether or not in a minor capacity, that reference should be positively included in the statement of the rejection (emphasis added).

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claim under 35 U.S.C. §103.

DECLARATION

Additionally, accompanying this Reply is a Declaration signed by the Inventor establishing the fact that the present invention, which is directed to the subject matter claimed was reduced to practice or conceived together with diligence on or before the January 10, 1996 date of the "X" reference cited above.

Thus, at least based on this Declaration, the rejection based on the "X" reference should be withdrawn.

SUMMARY

As set forth above, there is no *prima facie* case of obviousness with respect to the rejection of the claims provided in the last Office Action. Even assuming, for the sake of argument that there is a rejection that is valid, which it is not, further is enclosed a second Declaration of the Inventor regarding reduction to practice or conception and diligence of the invention on or before the effective date January 10, 1996 of the "X" reference referred to in the Office Action.

It appears that what the Patent Office has done is merely taken bits and pieces [words] of references and combined them without regard to the subject matter claimed and the improvement of the Inventor to the prior art.

Also, it appears what the Patent Office is doing is equating obviousness with capability. That is, the Office Action appears to be directed to the assertion that one skilled in the art having the references would be capable of making the combination in the context claimed. But obviousness and capability are not equivalent as set forth in the case of *Ex parte Levengood* 28 USPQ 2nd 1300 (BPAI 1993) which states in part as follows:

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at Appellants invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. (emphasis added)

For the reasons set forth above, the Examiner is requested to withdraw all the rejections and issue the present application.

CONCLUSION

Should the Examiner have any questions concerning this application, the Examiner is invited to contact Elliot A. Goldberg at (703) 205-8000 in the Washington, D.C. area.

Pursuant to the provisions of 37 C.F.R. § 1.17 and § 1.136(a), Applicant hereby petitions for an extension of one (1) month from May 17, 2000 to June 19, 2000 (as June 17 was a Saturday) in which to file a response to the outstanding Office Action. The required fee of \$55.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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